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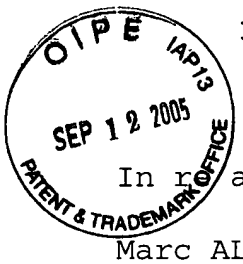

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of	)	
	)	
Marc ALIZON et al.	)	Group Art Unit: 1648
	)	
Serial No.: 08/384,248	)	Examiner: J. PARKIN
	)	
Filed: February 6, 1995	)	
	)	
For: METHOD OF PRODUCING ANTIBODIES TO ANTIGENS OF HUMAN IMMUNODEFICIENCY VIRUS TYPE 1 (HIV 1)	)	**Appeal No.: 2005-0398**

MAIL STOP APPEAL BRIEF-PATENTS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REQUEST FOR REHEARING

Pursuant to 37 C.F.R. § 41.52, Appellants request rehearing and reversal of the Decision On Appeal dated July 12, 2005.

REMARKS

Reconsideration of the Decision On Appeal dated July 12, 2005, is respectfully requested. The Board misapprehended or overlooked the following points in its decision. First, the Board overlooked the inherent disclosure of raising antibodies in Appellants' specification. Second, the Board has misconstrued Appellants' claims. In misconstruing Appellants' claims, the Board appears to have raised a new ground of rejection (i.e., under 35 U.S.C. §101 and/or § 102) of Appellants' claims over a "natural process" or over "prior art." *See* 37 C.F.R. § 41.50(b). If, in fact, the Board has raised a new ground of rejection, Appellants request that, instead of consideration of this Request, the accompanying Amendment be entered and prosecution reopened. *See id.*

The Board has overlooked Appellants' inherent disclosure of "raising antibodies"

On page 14, lines 1-4, Appellants' specification states: "All of the above (a-d) ***can be used*** in diagnostics ***as sources of immunogens*** or antigens free of viral particles, produced using non-permissive systems, and thus of little or no biohazard risk." First, the use of the phrase "can be used" demonstrates that Appellants' contemplated *methods of using* the HIV-1 antigens of "(a-d)." Second, this passage conveys that the

methods of using these antigens can involve using them as "immunogens."

Immunogens are substances that, when administered to a host animal, produce an immune response involving the production of antibodies and the activation of T cells. Thus, using a substance as an "immunogen" must mean "administering the substance to a host animal to produce an immune response involving the production of antibodies and the activation of T cells." The term immunogen is a term that applies to molecules that are used in a specific way to produce a specific result, namely, raising antibodies. Consequently, "raising antibodies" is an inherent aspect of using an antigen as an "immunogen."

Similarly, Appellants' specification states that the invention "relates to vaccine compositions whose active principle is to be constituted by any of the expressed antigens, i.e. whole antigens, fusion polypeptides or oligopeptides." (Specification at 14, lines 9-12.) This passage makes clear that the antigens can be used as vaccines that are "active." The only possible construction of the term "active" in relation to a "vaccine" is that an immune response is produced. Thus, the vaccines are "immunogens." The skilled artisan would understand that this inherently describes "raising antibodies."

Thus, Appellants' description on page 14 that recombinant HIV-1 peptides "***can be used*** in diagnostics ***as sources of***

immunogens" can only mean that Appellants' contemplated using recombinant HIV-1 peptides as immunogens to produce an inherent result, namely "raising antibodies." Neither the Board nor the Examiner have ever explained why Appellants' disclosure of using HIV-1 antigens as immunogens would not inherently convey to the skilled artisan the use of these antigens to raise antibodies, as recited in Appellants' claims. For these reasons, Appellants request reversal of the Decision.

The Board has misconstrued Appellants' claims

On pages 3-4 of the Decision, the Board construes Appellants' claims to encompass a human that is infected with HIV-1. The Board has misapprehended the scope of Appellants' claims.

Appellants' claims have two steps: a step of "providing an antigen" and a step of "raising antibodies." These steps are written in the *active* voice, and not in the passive voice (i.e., "were provided" and "were raised"). Thus, these steps require a human actor to provide an antigen and a human actor to raise the antibodies against the antigen. The skilled artisan would understand that these two steps require positive manipulations of the recited components of each step.

This construction is supported by Appellants' disclosure that HIV-1 antigens "*can be used in diagnostics as sources of immunogens.*" This passage makes clear that the skilled artisan,

who is reading the specification, is the actor providing the antigen and using it as an immunogen to raise antibodies. A human infected with HIV-1 would lack these positive manipulative steps. For these additional reasons, Appellants request reversal of the Decision.

Based on the Board's construction of the claims, the Board appears to have raised a new ground of rejection on pages 7-8 of the Decision by stating that "the evidence of record indicates that these ***methods were prior art methods*** not inventive to appellants" and "the claims ***include within their scope the natural process*** of raising antibodies when an individual is infected by HIV-1." Although the Decision did not use the term "rejection," the Board nonetheless appears to have raised a new ground of rejection under 35 U.S.C. § 101 and/or § 102, of Appellants' claims over a "natural process" or "prior art." *See* 37 C.F.R. § 41.50(b)

If, in fact, the Board has raised a new ground of rejection, Appellants request, pursuant to 37 C.F.R. § 41.50(b), that the accompanying Amendment be entered and prosecution reopened. Since 37 C.F.R. § 41.50(b) appears to treat the filing of an Amendment as an alternative to filing a Request for Rehearing, it is Appellants' understanding that a Request for Rehearing and an Amendment cannot both be filed. If this is the case, and the Board has raised a new ground of rejection,

Appellants request that the Amendment be entered and that this Request be disregarded.

Please grant any extensions of time required to enter this request and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER, L.L.P.

Dated: September 12, 2005

By: _____

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